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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,661

05/02/2008

Jon Kemppainen

6543US11

5723

68163 7590 08/10/2009  
LIFE TECHNOLOGIES CORPORATION  
C/O INTELLEVATE  
P.O. BOX 52050  
MINNEAPOLIS, MN 55402

EXAMINER

ROSENBAUM, MARK

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

08/10/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/576,661	<b>Applicant(s)</b> KEMPPAINEN ET AL.	
	<b>Examiner</b> Mark Rosenbaum	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-20 and 22-30 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-20 and 22-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/18/07</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What process step is being positively claimed here?

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by either Berchem or Trumpler. Both patents show media mills with non-spherical media.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Berchem or Trumpler in view of either DeStefan et al or Rajasekaran. Neither basic patent uses a roughened surface to help treat the material efficiently. Both secondary references disclose similar process and apparatus including the use of roughened surfaces to efficiently treat the material. In order to efficiently treat the

Art Unit: 3725

material, it would have been obvious for one of ordinary skill in the art to modify either Berchem or Trumpler by roughening the surfaces of the apparatus, taught to be desirable by both DeStefano et al and Rajasekaran.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Berchem or Trumpler in view of Boecker et al. Neither basic patent uses a screen or grill within the mill to help efficiently mill the material. Boecker et al solves this problem by disclosing similar apparatus and process including the use of plates that act as screens or grills within the mill. In order to efficiently mill the material, it would have been obvious for one of ordinary skill in the art to modify either Berchem or Trumpler by providing a screen/grill within the mill, taught to be desirable by Boecker et al.

Claims 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomes et al. This patent discloses the basic process and apparatus for milling biological samples in a media mill. The exact size of the media would depend on several factors such as material being treated and desired end results.

Claims 1-4,7-9,22,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomes et al in view of either Berchem or Trumpler. Tomes et al discloses the basic process and apparatus for treating biological material in a media mill. The media is spherical shaped which results in inefficient milling. Both Berchem and Trumpler solve this problem by disclosing similar apparatus and process including the use of irregularly shaped media. In order to efficiently mill the material, it would have been obvious for one of ordinary skill in the art to modify Tomes et al by using irregularly

Art Unit: 3725

shaped media, taught to be desirable by both Berchem and Trumpler. Note also that the use of a lysis buffer is well known in the art and of no patentable merit.

Claims 5,6,10,11,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomes et al in view of either Berchem or Trumpler as applied to claim 1 above, and further in view of either DeStefano et al or Rajasekaran. See above for the use of these secondary references.

Claims 12,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomes et al in view of either Berchem or Trumpler as applied to claim 1 above, and further in view of Boecker et al. See above for the use of Boecker et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Rosenbaum whose telephone number is 571-272-4523. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark Rosenbaum  
Primary Examiner  
Art Unit 3725

/Mark Rosenbaum/  
Primary Examiner, Art Unit 3725